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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER	
PARK, CHAN S	

ART UNIT	PAPER NUMBER
2625	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No.	Applicant(s)	
	10/659,304	SUN, HONG	
	Examiner	Art Unit	
	CHAN S. PARK	2625	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 October 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,8-11,13,14,16 and 19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 8-11, 13, 14, 16 and 19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/22/08 has been entered.

Response to Amendment

2. Applicant's amendment was received on 10/22/08, and has been entered and made of record. Currently, **claims 1, 8-11, 13, 14, 16 and 19** are pending.

Response to Arguments

3. Applicant's arguments with respect to **claims 1, 8-11, 13, 14, 16 and 19** have been considered but are moot in view of the new ground(s) of rejection.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, "the scanner including an operation unit" (claim 1) and "operating in a copy mode by setting a number of copies" (claims 1, 16 and 19) must be shown or the features canceled from the claims. Note that the scanner 12 shown in fig. 2 does not include an operation unit. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claim 19** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 19 recites a server being connected with a network of client computers wherein the scanner is connected to the network only through the server. However, the scanner 71 and a plurality of client computers 5 shown in fig. 7 of the Original Drawing show that they are connected to each other without the server. Clarification/explanation from the Specification is requested.

In the remarks filed on 10/22/08, the applicant appears to indicate that the scanner recited in claim 19 is described in fig. 2 of the Original Drawing (page 6 of the Remarks). However, the scanner 12 shown in fig. 2 does not include a printer selecting unit, an operation unit and a display controller. Again, clarification/explanation is requested as to where the scanner recited in claim 19 is shown in the Specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 1, 16 and 19** rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

MPEP 2173.03 recites,

> Although the terms of a claim may appear to be definite, inconsistency with the specification disclosure or prior art teachings may make an otherwise definite claim take on an unreasonable degree of uncertainty. In re Cohn, 438 F.2d 989, 169 USPQ 95 (CCPA 1971); In re Hammack, 427 F.2d 1378, 166 USPQ 204 (CCPA 1970). In Cohn, the claim was directed to a process of treating a surface with a corroding solution until the metallic appearance is supplanted by an "opaque" appearance. Noting that no claim may be read apart from and independent of the supporting disclosure on which it is based, the court found that the description, definitions and examples set forth in the specification relating to the appearance of the surface after treatment were inherently inconsistent and rendered the claim indefinite.

The claims recite the limitation of "when in the copy mode, the acquired image data is printed by the selected printer". It appears to indicate that the step of selecting is performed before or independent of the step of setting the operation mode. However, referring to fig. 6 of the Original Drawing, the step of setting the operation mode must be performed first. Note that this limitation appears to be read apart from the supporting disclosure on which it is based. Clarification/explanation from the Specification is requested.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 10, 11, 13 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Otake U.S. Patent No. 7,016,066.

With respect to claim 1, Otake discloses an image processing multifunction system (fig. 1) comprising:

a plurality of printers (fig. 1),

a printer selecting unit configured to select a printer to which image data is supplied (selecting a particular printer in a particular setting according to col. 17, line 64 ~ col. 18, line 33),

a server integrated with a scanner including an operation unit (controller 2000 in fig. 2 is construed as the claimed server since it provides image data to the network printers for the printing process), and

a display controller configured to make the operation unit of the scanner display the printer selected by the printer selecting unit (figs. 13~15), wherein

the scanner is configured to acquire image data of a document and the server is configured to send the image data acquired by the scanner to the printer selected by the printer selecting unit for printing (col. 12, lines 50-56); and

the operation unit is configured such that the scanner can be operated in a copy mode by setting (i) the copy mode (col. 12, lines 33-41), (ii) a number of copies (col. 13, lines 16-31), and (iii) a mode content using the operation unit (fig. 12), and when in the copy mode the acquired image data is printed by the selected printer and the selected printer is identified by the operation unit (col. 12, lines 50-56).

With respect to claim 10, Otake discloses the image processing multifunction system according to claim 1, wherein the printers have different printing performances (fig. 1).

With respect to claim 11, Otake discloses the image processing multifunction system according to claim 10, wherein the different printing performances include at least one of a difference in image quality, a difference in printing speed, and a difference between color printing and monochrome printing (fig. 1).

With respect to claim 13, Otake discloses the image processing multifunction system according to claim 1, wherein the printer selecting unit selects a printer that complies with a mode set by the operation unit of the scanner (figs. 21 & 22).

With respect to claim 16, Otake discloses a server (scanner 100 in conjunction with controller 2000) comprising:

a first interface to which plurality of printers are connected (LAN 1000 in figs. 1 & 2);

a printer selecting unit configured to select a printer to which image data is supplied (selecting a particular printer in a particular setting according to col. 17, line 64 ~ col. 18, line 33);

a scanner engine configured to acquire image data of a document (col. 12, lines 50-56);

an operation unit configured such that scanning can be conducted in a copy mode by setting (col. 12, lines 33-41), (ii) a number of copies (col. 13, lines 16-31), and (iii) a mode content using the operation unit (fig. 12);

a display controller configured to make the operation unit display the printer selected by the printer selecting unit (figs. 13~15), and when in the copy mode the acquired image data is printed by the selected printer and the selected printer is identified by the operation unit (col. 12, lines 50-56); and

a second interface to which a network is connected (either WAN 2051 or Local network 1100 in fig. 2),

wherein the server sends the image data acquired by the scanner engine to the printer selected by the printer selecting unit for printing (col. 12, lines 50-56).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otake as applied to claim 1 above, and further in view of James et al. U.S. Patent No. 6,584,539 (hereinafter James).

With respect to claim 8, Otake discloses the image processing multifunction system according to claim 1, but it does not explicitly disclose that the server and the printers are connected via a bus bridge.

James, the same field of endeavor of connecting a server with printers via a network (col. 4, lines 1-13), discloses that a server and printers are connected via a bus bridge (server 102 connected to printers via bus bridge 170 in fig. 1 & col. 3, lines 52-56).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of Otake to incorporate a bus bridge between the server and the printers as taught by James.

The suggestion/motivation for doing so would have been to provide a compatible connection between the server and printers that support different kinds of bus connections (col. 5, lines 1-17 of James). It would further enable the system of Otake to support other printers that support different bus connections.

Therefore, it would have been obvious to combine Otake with James to obtain the invention as specified in claim 8.

With respect to claim 9, Otake discloses the image processing multifunction system according to claim 1, but it does not disclose a data transmitting unit conforming a high-speed serial interface standard, wherein the data transmitting unit connects the server with the bus bridge, and the bus bridge with the printers.

James, the same field of endeavor of connecting a server with printers via a network (col. 4, lines 1-13), discloses a data transmitting unit conforming a high-speed serial interface standard (a serial interface that complies with the IEEE 1394 in col. 4, lines 101-14), wherein the data transmitting unit connects the server with the bus bridge, and the bus bridge with the printers (connecting device according to IEEE 1394 standard serial bus in fig. 1 & 21-39).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of Otake to include a data transmitting unit conforming a high-speed serial interface standard to connect the server, the bus bridge and the printers as taught by James.

The suggestion/motivation for doing so would have been to allow high-speed/throughput communication between devices (col. 4, lines 60-67 of James).

Therefore, it would have been obvious to combine Otake with James to obtain the invention as specified in claim 9.

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Otake as applied to claim 1 above, and further in view of Fujiwara et al. U.S. Patent No. 6,804,022 (hereinafter Fujiwara).

With respect to claim 14, Otake discloses the image processing multifunction system according to claim 1, but it does not explicitly disclose that the printer selecting unit selects a printer that is free.

Fujiwara, the same field of the server selecting a most appropriate printer for printing, discloses a server (server 2 in fig. 13) for selecting a printer that is free/unoccupied (server selecting the unoccupied printer in col. 13, line 63 ~ col. 14, line 7).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the printer selecting unit of Otake to incorporate the method of selecting a printer that is free/unoccupied as taught by Fujiwara.

The suggestion/motivation for doing so would have been to provide a faster printing by making the printer selection based on the status report received by the server (col. 13, lines 51-62 of Fujiwara).

Therefore, it would have been obvious to combine Otake with Fujiwara to obtain the invention as specified in claim 14.

10. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohara U.S. Patent No. 7,136,179 in view of Ohara U.S. Patent No. 7,136,179.

With respect to claim 19, Ohara discloses a scanner (scanner 2 in fig. 1) comprising:

an interface that is connected to a server (printing server 1 in fig. 1), wherein the server is connected with (i) a network of client computers (clients 4a~n) and (ii) a plurality of printers via distinct interfaces (printers 3 wherein each printer includes its own interfaces), manages and controls the printers (col. 4, lines 57-64), and the scanner is connected to the network only through the server (fig. 1);

a printer selecting unit configured to select a printer to which image data is supplied (BEST FIT mode in fig. 4A);

a scanner engine;

an operation unit (fig. 4); and

a display controller configured to make the operation unit display the printer selected by the printer selecting unit (fig. 4C), and supplies the image data to the printer selected by the printer selecting unit via the server and is identified by the operation unit (S511 in fig. 5).

Ohara, however, does not explicitly disclose a scanner having a copying mode wherein when in the a copying mode, the scanner reads image data from a document via the scanner engine by operating the operation unit by setting (i) the copy mode, (ii) a number of copies, and (iii) a mode content using the operation unit.

Otake, the same field of endeavor of transferring scanned image to a printer, discloses a scanner having an operation unit configured such that scanning can be

conducted in a copy mode by setting (col. 12, lines 33-41), (ii) a number of copies (col. 13, lines 16-31), and (iii) a mode content using the operation unit (fig. 12).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the scanner of Ohara to include the copying mode function as taught by Otake.

The suggestion/motivation for doing so would have been to provide an improved copying function at the scanner.

Therefore, it would have been obvious to combine Ohara with Otake to obtain the invention as specified in claim 19.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571)272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHAN S PARK/
Examiner, Art Unit 2625

December 7, 2008